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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/027,214

12/21/2001

Shlomo Dukler

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09/10/2004

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EXAMINER

GARCIA, GABRIEL I

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/027,214

Applicant(s)

DUKLER ET AL.

Examiner

Gabriel I Garcia

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 5/9/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6 and 7.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. Applicant is reminded of the proper language and format for an abstract of the disclosure. The form and legal phraseology often used in patent claims, such as "**comprises**" should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
3. The Abstract of the Disclosure is objected to because it contains the objectionable language described above. Corrections are required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 24, the phrase "substantially as described and illustrated" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Demers et al. (WO 98/40223).

With regard to claim 1, Demers et al teaches a difficult to counterfeit document (e.g. Counterfeit equivalent to difficult to duplicate used as security or authentication purposes, see also page 11) comprising, together with data printed in visible form(see abstract and fig. 1)), invisible indicia that are personalized in nature (see abstract and fig. 2., the invisible image can be changed, according to the use), and which cannot be seen without the cooperation of an external factor (see abstract, the image can only be seen using UV light).

With regard to claim 2, Demers et al further teaches wherein the invisible indicia are printed with a luminescent ink or toner (see page 7).

With regard to claims 3-4, Demers et al further teaches wherein the invisible indicia becomes visible by application of irradiation and wherein the luminescent ink or toner comprises fluorescent materials (see page 7).

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With regard to claim 5, Demers et al further teaches wherein the irradiation is UV light (e.g. page 7).

With regard to claims 6-9, Demers et al further teaches wherein the same type of document bears different invisible indicia for different bearer or documents, and is printed by conventional digital printing methods (see figs. 1-3, the invisible image can be changed, according to the document being used), and which can be printed by a laser printer, liquid ink printer, bubble jet or ink jet printer(see page 7).

With regard to claim 10, Demers et al further teaches comprising an image of the bearer, a signature, one or two dimensional barcode label, text matter or any other mark that can be printed in order to differentiate one document from the others (reads on fig. 1).

With regard to claim 11, Demers et al further teaches the selected document from among a number of documents (see page 15).

With regard to claims 12-24, the limitations of claims 12-24 are covered by the limitations of claims 1-11 above, and Demers et al further teaches laminating the documents (see page 1).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tan et al. (US 2003/0108689A1) teaches an ink with near infrared fluorophores and UV absorbers.

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Leon (US 2003/0028497A1) teaches a method and apparatus for postage label authentication.

Hayosh (6,600,823) teaches an apparatus and method for enhancing check security.

Outwater (6,536,672) teaches a product authentication system and method.

Moore (6,456,729) teaches an anti-counterfeiting and tracking system.

Liang (6,373,965) teaches an apparatus and methods for authentication using partially florescent graphics images and OCR characters.

Geiger et al. (6,349,972) teaches a coin discrimination voucher anti-counterfeiting method and apparatus.

Yang (6,343,204) teaches a detection and deterrence of counterfeiting of documents with tokens characteristic color and spacing.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (703) 305-8751. The examiner can normally be reached Monday thru Thursday from 7:30AM-6:00PM.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

or faxed to:

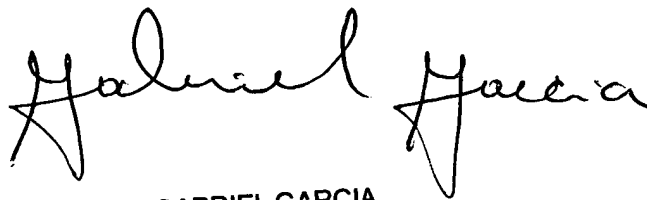
(703) 872-9306 (unofficial or official)

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**Gabriel I. Garcia**  
**Primary Examiner**  
**September 6, 2004**



GABRIEL GARCIA  
PRIMARY EXAMINER